

T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 31-May-05

TO: EXAMINER BOCCIO, VINCENT F.

FROM: Jefferson, Henry
PARALEGAL SPECIALIST

APPL. S.N.: 09/615,838

ART UNIT: 2616

RETURN THIS MEMO TO: Case Drop-Off Location
JEF-2D68

SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 23-May-05


INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. **THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE.** When your action is complete, please initial, date and return this memo to me. **THANK YOU.**

- ☒ The T.D. is PROPER and has been recorded (see ¶14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶ 14.24):
- ☐ The TD fee of has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶ 14.26.07).
 - ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶¶ 14.26 & 14.26.01).
 - ☐ The T.D. lacks the enforceable only during common ownership clause – needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see ¶ 14.27.01).
 - ☐ The T.D. is directed to a particular claim(s), which is not acceptable since “the disclaimer must be for a terminal portion of the term of the entire patent to be granted” (MPEP 1490) (see ¶¶ 14.26 & 14.26.02).
 - ☐ The person who signed the T.D.:
 - ☐ is not an attorney “of record” (see ¶¶ 14.29 and 14.29.01).
 - ☐ has failed to state his/her capacity to sign for the business entity (see ¶ 14.28).
 - ☐ is not recognized as an officer of the assignee (see ¶¶ 14.29 & possible 14.29.02).
 - ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).
 - ☐ The T.D. is not signed (see ¶¶ 14.26 & 14.26.03).
 - ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).
 - ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶¶ 14.26, 14.27.02 or 14.26.05).
 - ☐ The period disclaimed is incorrect or not specified (see ¶¶ 14.26, 14.27.02 or 14.26.03).
 - ☐ Other:
 - ☐ Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and **do not** check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: _____ Date: _____

Log Date: _____

Application Number 	Application No. 09/615,838	Applicant(s) BATTAGLIA ET AL.	

TERMINAL DISCLAIMER	<input checked="" type="checkbox"/> APPROVED	<input type="checkbox"/> DISAPPROVED
Document Code - DISQ INTERNAL DOCUMENT – DO NOT MAIL	This patent is subject to a Terminal Disclaimer	

U.S. Patent and Trademark Office

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

BATTAGLIA et al.

Serial No. 09/615,838

Filed: July 13, 2000

For: ENHANCED DIGITAL DATA COLLECTOR FOR REMOVABLE
MEMORY MODULES

Atty. Ref.: 2694-200

TC/A.U.: 2616

Examiner: V. Boccio

RECEIVED
CENTRAL FAX CENTER

MAY 23 2005

May 23, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TERMINAL DISCLAIMER

Your petitioner, SmartDisk Corporation, a corporation having an office and place of business at 3506 Mercantile Avenue, Naples, FL/USA 34104 represents that it is the assignee as recorded in an assignment at Reel 011413/Frame 0506, of all right, title and interest in and to Application Serial No. 09/615,838, filed July 13, 2000, for ENHANCED DIGITAL DATA COLLECTOR FOR REMOVABLE MEMORY MODULES. Your petitioner also represents that it is the assignee as recorded in an assignment at Reel 015841/Frame 0451, of all right, title and interest in and to Application Serial No. 09/149,448, now U.S. Patent No. 6,658,202, issued December 2, 2003, for PORTABLE DATA TRANSFER AND MASS STORAGE DEVICE FOR REMOVABLE MEMORY MODULES.

5/24/2005 HTECKLU1 00000026 141140 09615838

01 FC:1814 130.00 DA

BATTAGLIA et al.
Serial No. 09/615,838

Your petitioner hereby disclaims the terminal part of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term as presently shortened by any terminal disclaimer of Patent No. 6,658,202 and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to such patent granted on the above-identified application shall be the same as the legal title to the above-identified Patent No. 6,658,202, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term as presently shortened by any terminal disclaimer of Patent No. 6,658,202 in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

The evidentiary documents accompanying this document or referred to above have been reviewed by the undersigned and it is certified that to the best of the assignee's knowledge and belief, title is in the assignee seeking to take action.

Check either box 1 or 2 below, as appropriate.

BATTAGLIA et al.
Serial No. 09/615,838

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

2. ☒ The undersigned is an attorney or agent of record.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



Mark E. Nusbaum
Reg. No. 32,348

MEN:mg
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100

☒ Terminal disclaimer fee under 37 C.F.R. § 1.20(d) included. If missing, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

05/23/05

14:45

NIXON & VANDERHYE 703 816 4100 → USPTO

NO. 731 001

RECEIVED
CENTRAL FAX CENTER

MAY 23 2005

Nixon & Vanderhye PC.
ATTORNEYS AT LAW11TH FLOOR
901 NORTH GLEBE ROAD
ARLINGTON, VIRGINIA 22203-1808TELEPHONE: (703) 816-4000
FACSIMILE: (703) 816-4100
WRITER'S DIRECT DIAL NUMBER:
(703) 816-4020**FACSIMILE COVER SHEET**
PLEASE DELIVER IMMEDIATELY!!!!Our Ref.: 2694-200
Serial No.: 09/615,838 Date: May 23, 2005To: Vincent Boccio
Firm: U.S. Patent and Trademark Office
Facsimile No.: 703-872-9306
From: Mark E. NusbaumNumber of Pages (including cover sheet): 6
(IF YOU DO NOT RECEIVE ALL OF THE PAGES OR ENCOUNTER DIFFICULTIES IN TRANSMISSION,
PLEASE CONTACT US IMMEDIATELY AT (703-816-4000).mg
FACSIMILE OPERATOR

ATTACHMENT/S:

MESSAGE:RECEIVED
MAY 24 2005
DIPE/JCWS**CONFIDENTIALITY NOTE**

The documents accompanying this facsimile transmission contain information belonging to Nixon & Vanderhye, which is confidential and/or legally privileged. This information is only intended for the use of the individual or entity named above. IF YOU ARE NOT THE NAMED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISCLOSURE, COPYING, DISTRIBUTION OR TAKING OF THIS INFORMATION FOR ANY USE WHATSOEVER IS STRICTLY PROHIBITED. If you have received this facsimile in error, please immediately contact us by telephone to arrange for return of the original documents to us.

PAGE 1/6 * RCVD AT 5/23/2005 2:54:02 PM [Eastern Daylight Time] * SVR:USPTO-EFAX-1/2 * DNS:8729306 * CSID:703 816 4100 * DURATION (mm-ss):01:48 957250